Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte DAN A. NICKENS and CHARLES C. MATTERN

Appeal No. 1998-3402
Application No. 08/190,929

ON BRIEF

Before CALVERT, NASE, and JENNIFER D. BAHR, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 15, 18 and 19. Claims 16 and 17, the only other claims pending in this application, have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention.

We REVERSE.

BACKGROUND

The appellants' invention relates to a waste treatment system. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Brooks	3,719,028	Mar. 6, 1973
De Gregorio	3,926,135	Dec. 16, 1975
Gablin et al. (Gablin)	4,168,243	Sep. 18, 1979
Nguyen	4,255,168	Mar. 10, 1981
Hay et al. (Hay)	4,875,420	Oct. 24, 1989
Mattern	5,383,499	Jan. 24, 1995

(filed May 4, 1992)

Earth Resources Corporation, Statement of Qualifications and Experience Compressed Gas Management Services, pp. 1-44

Claims 4 and 5 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 1 to 5, 9, 13 to 15, 18 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hay or Brooks in view of Mattern, Gablin and De Gregorio.

Claims 6 to 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hay or Brooks in view of Mattern, Gablin and De Gregorio as applied to claim 1 above, and further in view of Nguyen.

Claims 10 to 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hay or Brooks in view of Mattern, Gablin and De Gregorio as applied to claim 1 above, and further in view of Earth Resources Corporation.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted

rejections, we make reference to the answer (Paper No. 26, mailed February 19, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 25, filed December 15, 1997) and reply brief (Paper No. 27, filed April 20, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We will not sustain the rejection of claims 4 and 5 under 35 U.S.C. § 112, second paragraph.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the

metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

The examiner rejected claims 4 and 5 as being indefinite since there was no structural difference between the two claims (answer, p. 4). We do not agree for the following two reasons.

First, we agree with the appellants' position set forth in the brief (pp. 5-6) and the reply brief (p. 1) that claims 4 and 5 are structurally different. In that regard, the "adapted to" language used in each of claims 4 and 5 is a structural limitation, not merely a description of how the chamber is used. See In re Venezia, 530 F.2d at 958-59, 189 USPQ at 151-52.

Second, even if the examiner would have been correct that claims 4 and 5 were redundant (i.e., no structural difference), we fail to find any basis for a rejection under the second paragraph of 35 U.S.C. § 112 since each claim

defines the metes and bounds thereof with a reasonable degree of precision and particularity.[1]

For the reasons set forth above, the decision of the examiner to reject claims 4 and 5 under 35 U.S.C. § 112, second paragraph, is reversed.

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[1] It appears to us that a redundant claim can be objected to by the examiner as failing to comply with the requirement of 37 CFR § 1.75(b) that claims differ from each other. See MPEP § 706.03(k) (Seventh Edition, Rev. 1, Feb. 2000).

The obviousness rejections

We will not sustain the rejection of claims 1 to 15, 18 and 19 under 35 U.S.C. § 103.

Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. In rejecting claims under
35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill

in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Here, it is clear to us that the prior art contains none. In fact, the advantages of utilizing a distribution manifold connected to a plurality of waste treatment units and a waste source as recited in the claims under appeal are not appreciated by the prior art applied by the examiner.

Instead, it is quite apparent to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which

only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id. Since the claimed subject matter as recited in the claims under appeal is not taught or suggested by the applied prior art, the decision of the examiner to reject claims 1 to 15, 18 and 19 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 4 and 5 under 35 U.S.C. § 112, second paragraph, is

reversed and the decision of the examiner to reject claims 1 to 15, 18 and 19 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT Administrative Patent Judge	)
JEFFREY V. NASE Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)

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